REMARKS

This responds to the Final Office Action dated April 30, 2010. Claims 87, 101, 125, 136, 139, 246 and 247 are amended; claims 98, 104, 248-263 are canceled; and no claims are added; as a result, claims 68-97, 99-103, 105-143, and 246-247 are now pending in this application.

Improper Final Action/Examiner Interview Summary

The Office Action includes a new ground of rejection, a rejection under 35 U.S.C. § 251 that was not raised in the prior Office Action. Applicants did not amend the application in response to that prior Office Action, and thus this rejection was not in any way necessitated by an amendment of Applicants. Applicants therefore respectfully submit that the finality of the current Office Action is improper, and therefore request the withdrawal of the finality of the current Office Action. Telephonic interview was conducted between Examiner Pendleton and Elena Dreszer. In the course of the interview, it was brought to the Examiner's attention that the outstanding Office Action should not have been made final because a new ground of rejection under 35 U.S.C. § 251 was presented on unamended claims. Agreement has been reached. Applicants thank the Examiner for agreeing to change the status of the case to Non-Final rejection, as indicated in the Examiner Interview Summary mailed on June 29, 2010.

Litigation Status of U.S. Patent No. 5,819,034

The Office Action states that the patent sought to be reissued by this application is involved in litigation. While this was true at one time, the litigation in which U.S. patent no. 5,819,034 was involved (Civil Action No. C-02-00655, ND CA) has been concluded, and the patent is no longer involved in litigation. A copy of the Consent Judgment terminating the litigation as of November 7, 2007 is submitted herewith.

As the subject litigation has been concluded, as evidenced by the Consent Judgment, Applicants request: (1) retraction of the indication that the patent sought to be reissued by this application is involved in litigation; and (2) removal of any restrictions on the current

prosecution, such as the preclusion of extensions of time under the provisions of 37 C.F.R. § 1.136(a).

Rejection of the Claims Under § 103

A. *The Rejection over Florin and Hendricks*

Claims 68-78, 82-83, 85-94, 97-104, 106-116, 120-121, 123 -132, 135-142 and 246 - 263 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Florin (U.S. Patent No. 5,583,560) in view of Hendricks (U.S. Patent No. 5,990,927). As will be set forth below, Applicants respectfully submit that the references do not contain the teachings attributed to them, and therefore fail to disclose the limitations of the rejected claims.

Claims 98, 104, and 248-263 were cancelled.

The Combination of Florin and Hendricks Fails To Disclose Using a Server to Transmit to a Client Both a Television Program and a Computing Application, as Recited in Claims 68-86, 106-124 and 139-143

The Office Action relies on Florin to teach the limitation of: "using a server to transmit to a client both a television program and a computing application,"[1] as recited in claim 68, citing Florin at column 8, lines 52-54 for that teaching. That passage, however, does not teach transmission or receipt of "a computing application comprising executable code" to be executed at the client; but teaches only the receipt of audio-visual signals and digital data:

> The A/V connect module 66 switches and receives *analog audio-visual signals and digital data* from a plurality of audio-visual sources, including the T/T cable 52, the video cassette recorder (VCR) 56, or the other A/V devices 57 and couples those signals and data to the main module 62 through the video decoder 74.[2]

The Confusion of Digital Data with a Computing Application

In further explanation of the above interpretation, the Office Action apparently seeks to equate encoded data with "a computing application." In the Response to Arguments section, the Office Action seems to suggest that a computing application is disclosed in Florin by virtue of

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[1] Office Action, page 9.
[2] Florin at column 8, lines 52-55 (emphasis added).

disclosure of encoded data transmitted in the vertical blanking interval ("VBI") that is not

displayed on the screen:

> . . . it would be understood by one of ordinary skill in the art, from the
> section about general system configuration in Florin that the AV module
> receives data and sends it to the decoder 74, the decoder is further
> described in Col. 9 as decoding data from the vertical blanking interval
> [VBI] or special side-band cable channel. As it is very well know [sic]
> that the data carried in the VBI is not displayed on the screen and that the
> data usually consists of triggers, time codes and other data that facilitate
> user interaction.[3]

Applicants certainly take issue with the broad generalization that data carried in the VBI

usually consists of "other data that facilitate user interaction," or that the hypothesized triggers

and time codes facilitate user interaction. Aside from that issue, however, the result of the

assertions of the Office Action is that transmitted data equates to a transmitted "computing

application" if: (1) the data is encoded in some way; and (2) if the data is not displayed on a

screen.

Of course, as is well known to those skilled in the art, virtually any stored or transmitted

data is "encoded" in some way, whether it is encoded as a certain file type (.txt, .avi, .jpg, etc.) or

in a certain format for network transmission. And as is just as well known to those skilled in the

art, most if not all such encoded file types contain some information that is not displayed,

presented or heard (as appropriate, depending upon the file type). Metadata is just one example

of such non-displayed information, but additional information is found in various video and

streaming applications that is not displayed or otherwise presented to a user.

Because the above-discussed attributes of the digital data of Florin that are asserted by

the Office Action to constitute a "computing application" are inherent to most instances of digital

data, Applicant submits that the position of the Office Action that Florin's "data" and "digital

data" represent "a computing program" is, in reality, a position that virtually any "digital data"

represents a computing program, regardless of the nature or content of that digital data--whether

that digital data is a digital text file (such as a word processing file), a digital music file (such as

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[3] Office Action, page 2.

an MP3 file), an image file (such as a JPEG file), a video data stream (whether from a DVD, VCR or a satellite broadcast, etc.). Applicant respectfully requests the Examiner to clearly state if this is the interpretation that is intended -- -- that any digital file or digital data stream, whenever the nature or composition, represents a "computing program." If that is not the intended position, then Applicants need specificity about exactly what attributes of "digital data" the Examiner considers necessary to render that data a "computing program," and an identification of where those attributes are disclosed by Florin relative to the identified "digital data."

The lack of clarity of the positions in the Office Action can also be found in a distinction that is, at best, difficult to reconcile with the knowledge and understanding of those skilled in the art. Specifically, the Office Action states that Florin discloses a "computing application,"[4] but that Florin does not "teach the presence of executable code."[5] This distinction is apparently not raised to distinguish source code from object code, at least it is never stated as such. The claim limitation of "computing application including executable code" is meant to expressly establish what is inherent in the art, that a "computing application" is to be executed, and thus includes "executable code;"[6] otherwise, the instructions of the program would not be executable. The Office Action therefore attempts to draw a distinction that does not exist. If Florin does not disclose executable code (as admitted in the Office Action), then it does not disclose a computing program that can be executed at the client (as required by claim 68).

Applicants submit that Florin does not teach a transmission comprising a computer program or a computer program comprising executable code (as is correctly stated by the Office Action[7]). As a result, Florin does not disclose the claimed functionality of the transmitted executable code when it is executed-- that it "cause display of interactive information associated with the television program." Because Florin fails to disclose that display of interactive

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[4] Office Action, page 9.
[5] Office Action, page 11.
[6] For example, Wikipedia identifies a computer program as "a sequence of instructions written to perform a specified task for a computer. . . . The program has an executable form that the computer can use directly to execute the instructions."
[7] Office Action, p. 11, (citing Hendricks at column 27, lines 23-40).

information, the reference also cannot disclose the subsequent step resulting from interaction with the displayed interactive information, "detecting, at the server, a signal representing a viewer interaction with the interactive information."

In furthering the above-discussed construction that Florin can disclose transmission of a computing application, but does not disclose "executable code," the Office Action cites Hendricks to show "executable code." In the cited passage, Hendricks is describing a "hardware upgrade," a "Level C interactive unit with compact disc capability" that may be used with a set top terminal.[8] This interactive unit, explains Hendricks, may include a high volume local storage capacity such as a CD-ROM shown in Fig. 12a. Hendricks identifies that the interactive unit allows the use of interactive multi-media applications, such as, e.g., computer games and educational software. Hendricks also identifies that "many of these applications will interact with live programming providing additional information and interactivity to the basic program feed," such as, in one example, retrieving additional information about that program subject matter that is stored on the CD.[9]

Thus, all Hendricks discloses of pertinence is the possible use of a compact disc that can store one or more applications of various types. Those applications are <u>not</u> transmitted to a client <u>along with</u> the television program, but instead the applications are stored on a compact disc or other random-access digital data format that is accessible to the set top terminal. Thus, even assuming – solely for purposes of argument-- that there could be some motivation to combine the teachings of the two references (which is not in any way conceded), combining the system of Florin (transmitting audio-visual signals and digital data) with that of Hendricks (accessing software applications locally stored at a set top box) still fails to disclose any source <u>transmitting both a television program and a computing application with executable instructions</u> to a client. Thus, even if the combination is made, it does not disclose or suggest "<u>using a server to transmit</u> to a client <u>both</u> a television program *and a computing application comprising executable code*, the executable code to be executed at the client to cause display of interactive information

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[8] Hendricks, column 26, lines 8-16 (describing various "hardware upgrades" including a "Level C interactive unit with compact disc capability," which is the specific unit being addressed in the cited passage from column 27).
[9] Hendricks, col. 27, lines 23-40.

associated with the television program while the television program is being displayed at the client," as recited in claim 68, and thus cannot render claim 68 and its dependent claims obvious.[10]

Independent claims 106, 139, and 247, and their respective dependent claims require using a server to transmit, to a client, both television programming and a computing application comprising executable code, and are thus patentable for at least the reasons discussed above relative to claim 68. Applicants therefore request the reconsideration and withdrawal of this rejection of claims 68-86, 106-124, and 139-143 and 247.

The Combination of Florin and Hendricks Fails to Disclose the Television Programming and the Computing Application Being Provided or Received in a Series of Multiplexed Packets, Ones of Which Contain Data Representing the Video, and Others of Which Represent the Executable Code

Claims 87, 101, 125, and 246, as amended, recite similar distinctions over the art, from the client side. Claims 87, 125 and 247 each recite "receiving, at a client both television programming and a computing application comprising executable code the television programming and the computing application provided in a series of multiplexed packets, ones of which contain data representing the video, and others of which represent the executable code." Claim 101 recites a similar distinction, except the recited step is one of "providing to the client" the recited components in a stream of multiplexed packets. The limitation that the server provides data in a series of multiplexed packets, ones of which contain data representing the video, and others of which represent the executable code was previously recited in claim 104, currently cancelled. The Office Action relies on Florin to disclose this limitation,[11] citing Florin at column 8 line 52 through column 9 line 4 and column 10 lines 32-44. For all the reasons discussed above relative to claim 68, however, Florin, however, does not teach transmission (or providing) *or receipt* of a computing application comprising executable code; but teaches only the receipt of audio-visual signals and digital data, as discussed above.

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[10] *KSR v. Teleflex,* 82 U.S.P.Q.2d at 1395 (2007) ("A rationale to support a conclusion that a claim would have been obvious is that **all the claimed elements were known** in the prior art . . .").
[11] Office Action, page 13.

For corresponding reasons to those discussed relative to the failure of the combination of references to disclose transmission of both a television program and a computing application comprising executable code, combining Florin with Hendricks does not cure this deficiency of Florin. As noted above, Hendricks discloses the possible use of a compact disc that can store one or more applications of various types. As pointed out above, those applications are not transmitted to a client along with the television program, but instead the applications are stored on a compact disc or other random-access digital data format. Thus, even if the combination is made, it does not disclose or suggest "the television programming and the computing application received [or provided] in a series of multiplexed packets, ones of which contain data representing the video, and others of which represent the executable code," as recited in claims 87, 101, 125, and 246, and thus cannot render claims 87, 101, 125, and 246 and their respective dependent claims obvious.[12] Applicants therefore request the reconsideration and withdrawal of this rejection of claims 87-97, 99-103, 105, 125-138, and 246.

B.   The Rejection over Florin, Hendricks and Coddington

Claims 79-81, 95-96, 117-119, and 133-134 were rejected under 35 U.S.C. 103(a) as being unpatentable over Florin, patent number: 5,583,560 in view of Hendricks (U.S. Patent No. 5,990,927) in further view of Coddington (U.S. Patent No. 5,410,343). Claims 79-81, 95-96, 117-119, and 133-134 depend, directly or indirectly, from claims 68, 87, 106, and 125 respectively and therefore all depend from an independent claim discussed relative to the prior rejection, which is believed to have been shown to be patentable over the applied references. Thus each of rejected claims 79-81 is allowable, at least, as depending from an allowable independent claim. Applicants therefore request the reconsideration and withdrawal of this rejection of claims 79-81.

C.   The Rejection over Florin, Hendricks and Banker

Claims 84, 105, 122, and 143 are rejected under 35 U.S.C. 103(a) as being unpatentable over Florin (U.S. Patent No. 5,583,560) in view of Hendricks (U.S. Patent No. 5,990,927) in

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[12] *KSR v. Teleflex,* 82 U.S.P.Q.2d at 1395 (2007) ("A rationale to support a conclusion that a claim would have been obvious is that *all the claimed elements were known* in the prior art . . .").

further view of Banker (U.S. Patent No. 5,485,221). Claims 84, 105, 122 and 143 depend from claims 68, 101, 106, and 139 respectively and each is therefore allowable at least as depending from an independent claim that has been shown to be allowable by this response. Applicants therefore request the reconsideration and withdrawal of this rejection of claims 84 and 143.

The Rejection of Claims Under § 251

A.   Rejection Based on a Defective Reissue Declaration

Claims 68-78, 82 - 83, 85 - 94, 97 -104, 106 -116, 120 -121, 123 -132, 135 - 142 and 246 - 263 were rejected as being based upon a defective reissue declaration under 35 U.S.C. § 251 as set forth above. While Applicants do not concede the propriety of this rejection, in an effort to advance prosecution as efficiently as possible, a Substitute Reissue Declaration is being filed herewith. This Substitute Reissue Declaration now clearly contains the required statement identified in the Office Action.

B.   Rejection Based on Untimely Filing of Broadened Claims

Claims 68-78, 82 - 83, 85 - 94, 97 -104, 106 -116, 120 -121, 123 -132, 135 - 142 and 246 - 263 were rejected under 35 U.S.C. § 251 as being broadened in a reissue application filed outside the two year statutory period.

U.S. patent no. 5,819,034 issued on October 6, 1998. Within two years of that issue date, on September 27, 2000, reissue patent application no. 09/672,523, seeking to reissue U.S. patent no. 5,819,034 was filed. That reissue application, as filed, included claims 68-78, 82 - 83, 85 - 94, 97 -104, 106 -116, 120 -121, 123 -132, 135 - 142 and 246 – 263; and those same claims were contained within the present application as originally filed.

The present application is a divisional of originally-filed reissue patent application no. 09/672,523, and is thus entitled to the benefit of the filing date of that originally-filed reissue application under 35 USC § 120; and each of claims 68-78, 82 - 83, 85 - 94, 97 -104, 106 -116, 120 -121, 123 -132, 135 - 142 and 246 - 263 has an effective filing date of September 27, 2000 -

within the two-year limit for broadening reissue applications. Accordingly, Applicants request the reconsideration and withdrawal of this basis of rejection under § 251.

C.   Rejection Based on the Claims Being Directed to a Distinct Invention

The Office Action rejected claims 68-78, 82 - 83, 85 - 94, 97 -104, 106 -116, 120 -121, 123 -132, 135 - 142 and 246 - 263 under 35 U.S.C. § 251, stating that these claims "satisfy the 'recapture rule' preventing a patentee from receiving a reissue patent."[13]

Applicants submit that the reasoning in the Office Action, based on selected portions of MPEP 1412.02, is applied inappropriately, resulting in an improper rejection based on recapture under § 251. Applicants do not believe that there is any dispute about the current claims being drawn to a different invention than are the claims in the original U.S. patent no. 5,819,034 (herein "the '034 patent"). In fact, the basis for this rejection appears to come down to a position that the current claims represent recapture specifically because the current claims are directed to an invention different from that of the originally-issued claims. The Office Action states:

In the instant case, the reissue claims do not include any subject matter of the patented claims (independent patented claims 1, 6, 9, 10), but instead the subject matter that materially narrows the reissue claims is directed to a distinct and different invention and it is not the overlooked aspect of the original invention.[14] The recapture rule and the scenarios under which the recapture rule bars reissue claims are addressed in MPEP § 1412.02 titled "Recapture of Canceled Subject Matter." MPEP § 1412.02 (I)(C) is clear in identifying a recapture analysis, but expressly provides that notwithstanding that stated recapture analysis, there is an exception for claims directed to additional inventions/embodiments not originally claimed:

> If, however, the reissue claim(s) are really claiming additional
> inventions/embodiments/species not originally claimed (i.e., overlooked
> aspects of the disclosed invention), then recapture will not be present.[15]

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[13] Office Action, page 6.
[14] Office Action, pages 8-9.
[15] MPEP 1412.02 (I)(C).

This passage also makes clear that there is <u>not a difference</u> between submission of claims to an additional invention not previously claimed, and claims to overlooked aspects of the present inventions, as asserted in the Office Action (as quoted above), as the latter is stated as a clarification or example of the former.

This is exactly the situation presented here, as expressly acknowledged by the Office Action. What is in accordance with the guidance of MPEP § 1412.02, is that the current claims are directed to an invention that was not originally claimed (previously overlooked aspects)— specifically, either: (1) using a server to transmit to a client both a television program and a computing application comprising executable code; or (2) receiving at [or, providing to] a client both television programming and a computing application comprising executable code, the television programming <u>and the computing application received in a series of multiplexed packets, ones of which contain data representing the video, and others of which represent the executable code</u>. And claiming of this new invention represents an exception to the recapture rules, as expressly stated in MPEP § 1412.02 (I)(C). .

In summary, the present reissue claims are clearly claiming a different invention from that originally claimed. And in that situation, under 35 USC § 251 and the guidance of MPEP § 1412.02, there should be not be a rejection on recapture. Applicants therefore request that the rejection be withdrawn.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 278-4052 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this ___30___ day of July, 2010.

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Name   Signature